REMARKS

In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application. Claims 1-4, 6-7, 23, 29, 31-34, and 37 are currently amended. Claims 5, 8-22, 30, 35, and 38-47 are canceled without prejudice. Claims 24-28 and 36 are original. Claims 1-4, 6-7, 23-29, 31-34, and 36-37 are pending.

Rejections Under 35 U.S.C. §101

Claims 1-7 and 23-37 stand rejected under 35 U.S.C. §101. The Office states that these claims are directed to non-statutory subject matter.

Applicant amends independent Claims 1, 23, 29, and 34 to address this rejection.

The §103 Rejections

Claims 1-3, 23-29, 31-34, and 36-37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the alleged "Applicant's own admitted prior art in the background of the invention" in view of U.S. Patent No. 5,771,384 to Remington et al. (hereinafter, "Remington").

Applicant amends Claim 1 to comprise the subject matter of Claim 5, Claim 29 to comprise the subject matter of Claim 30, and Claim 34 to comprise the subject matter of Claim 35 and for matters of form. Claims 5, 30, and 35 were not rejected except under 35 U.S.C. §101, which Applicant addresses in current amendments to Claims 1, 29, and 34, respectively. Claims 2-4 and 6-7, 31-33, and 36-37 depend from Claims 1, 29, and 34, respectively, and are allowable as depending from an allowable base claim. These claims are also allowable for their

own recited features that, in combination with their base claim, are neither disclosed nor suggested in references of record, either singly or in combination with one another.

Regarding Claims 23-28, Applicant submits that the Office fails to establish a *prima facie* case of obviousness and, in view of the comments below, respectfully traverses the Office's rejections. Before discussing the substance of the Office's rejections, however, a section entitled "The §103 Standard" is provided and will be used in addressing the Office's rejections. Following this section, a section entitled "The Remington Reference" is provided, which describes Remington's disclosure and teachings.

The §103 Standard

To establish a *prima facie* case of obviousness, three basic criteria *must* be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Hence, when patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine or

modify the references relied on as evidence of obviousness. The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").

The Remington Reference

Generally, Remington directs his disclosure and invention to mechanisms for storing information in a computer system. *See Remington*, column 4, lines 18-21 and Abstract. In the Summary of the Invention section, Remington provides additional detail about his invention, stating that it relates to data processing systems and, more particularly, to the programmability of containers within data processing systems. *Remington*, column 3, lines 35-51.

In providing examples of his invention, Remington states that an "event" is a message generated by a container to apprize another entity that a specific event occurred. *Remington*, column 8, lines 39-40. Remington continues, stating that "[e]vents are associated with the adding and removing of items from a container." *Remington*, column 9, lines 11-12. And that an "event handler is invoked every time that an item is attempted to be moved or copied into [a] container." *Remington*, column 15, lines 24-27.

Thus, the focus of Remington's disclosure is storing information in containers.

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Response to the §103 Rejections

Preliminarily, in making out the rejection of Claims 23-28, the Office argues the Remington reference and uses language that does not appear in these claims. To the extent that the terminology utilized by the Office in making out these rejections varies from the specific claim language that appears in these claims, Applicant respectfully submits that the Office has improperly addressed these claims.

For the Office's convenience, Applicant sets forth the language of independent Claim 23, followed by the Office's reasoning in rejecting Claim 23.

Claim 23, currently amended, recites a designer attached to an editor that is implementable on a computing device, comprising a pre-event handler that processes an editing event from the editor before the editor processes the event.

The Office's reasoning:

> Regarding claims 1, 2, 3, 23, 24, 25, 29, 33, 34 and 37, applicant's own admitted prior art teaches a extensible document editor with event handler, wherein the extension is coupled to editor and the extension is configured to process editing events as described in the instant specification page 1, lines 7-page 2, line 17.
>
> Applicant's own admitted prior art although suggest providing editing events to the extension prior to the default event handler processing the editing events. Remington et al do. Specifically, Remington et al. teaches the extension functionality as described in col. 4, lines 30-32. Event handlers are described in col. 4, lines 66-col. 5, lines 2. Providing the events to extension through pre-event and post-event processing prior to default processing is described in col. 9, lines 10-15.
>
> Therefore it would have been obvious to a person with ordinary skill in the art at the time the invention was made to implement event handling technique of Remington et al in the editor of applicant's own admitted prior art because it provides added flexibility for document editing over default processing.

Office Action, page 3.

Applicant submits that the Office fails to establish a *prima facie* case of obviousness in rejecting Claim 23 by failing to establish that each and every element of Claim 23 is taught or suggested by the references. *See In re Royka, supra.*

Applicant previously argued that the Office's argument did not establish that the application's background at page 1, line 7 to page 2, line 17, teaches a "pre-event handler" as required by Claim 23. In response, the Office in its "Response to Arguments" section, argues that the broadest reasonable interpretation of an event handler is any step or device or process that handles an event. Based on this, the Office concludes that because the application's background teaches an editor that acts on an event, that the application's background teaches an event handler as required by Claim 23.

Applicant notes that Claim 23 recites "a pre-event handler that processes an editing event <u>from the editor before the editor processes the event</u>." The Office argues that Claim 23's pre-event handler is equivalent to the editor. If this is the case, Claim 23 makes no sense. The Office is effectively arguing that the term "pre-event handler" may be replaced with an editor that handles an event. If this is true, Claim 23 would read:

A designer attached to an editor that is implementable on a computing device, comprising ~~a pre-event handler~~ an editor that processes an editing event from the editor before the editor processes the event.

Claim 23 requires that the editor and pre-event handler be distinct entities. The pre-event handler processes an editing event <u>from</u> the editor. The pre-event

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1   handler processes the editing event <u>before</u> the editor processes the event. The

2   Office's argument requires that Claim 23's "editor" process an event from the

3   same editor before that same editor processes the event. This is nonsense. The

4   Office's argument twists the meaning of Claim 23 to require that the editor and the

5   pre-event handler not be distinct entities. But Claim 23 requires that the editor and

6   pre-event handler be distinct entities. For at least this reason, the Office fails to

7   establish a *prima facie* case of obviousness in its rejection of Claim 23.

8   Also, the Office argues that because the application's background teaches

9   an editor that acts on an event, that the application's background teaches an "event

10   handler." But Claim 23 requires a "<u>pre</u>-event handler." The Office, however, fails

11   to even mention a "<u>pre</u>-event handler," instead only mentioning an "event

12   handler." The Office has not shown that a "<u>pre</u>-event handler" is taught by an

13   "event handler." In failing to do so, even if the application's background does

14   teach an event handler, the Office fails to establish that the application's

15   background teaches a "<u>pre</u>-event handler" as required by Claim 23. Also for this

16   reason the Office fails to establish a *prima facie* case of obviousness in its

17   rejection of Claim 23.

18   Applicant also submits that the Office fails to establish a *prima facie* case

19   of obviousness in rejecting Claim 23 by failing to provide sufficient reasoning for

20   combining the application's background and Remington. The Office argues that

21   "it would have been obvious for a person with ordinary skill in the art at the time

22   the invention was made to implement event handling technique of Remington et al

23   in the editor of applicant's own admitted prior art because it provides added

24   flexibility for document editing over default processing." *Office Action*, page 4.

25

Remington's disclosure, as described above, is directed to mechanisms for storing information in a computer system. The Office has not shown why one skilled in the art at the time the invention was made would have been motivated to combine a disclosure directed to storing information in a computer system with the application's disclosure in the background section. Stating that "it would have been obvious ... to implement event handling technique of Remington et al in the editor of applicant's own admitted prior art because it provides added flexibility for document editing over default processing" does not meet the requirements of the law; the Office must show that there is a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See In re Jones, supra.* The Office must also provide—with specificity—evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine or modify the references relied on as evidence of obviousness. *See In re Kotzab, supra.*

On its face, the Office's argument fails to establish with particularity a suggestion or motivation to modify the application's alleged disclosure.

In addition, Remington contravenes combination with the application's background section. Remington is relied on by the Office to teach handling of events. But the "events" of Remington are not the events in the application's background. Remington states that an "event" is a message generated by a container to apprize another entity that a specific event occurred. *Remington,* column 8, lines 39-40. Remington also states that "[e]vents are associated with the adding and removing of items from a container." *Remington,* column 9, lines 11-12. In both of these examples, the events of Remington do not teach the

events in the application's background. A careful reading of Remington would thus lead one skilled in the art away from combining Remington with the application's background. Adding this to the general teaching of Remington, which focuses on storing information in a computer system, the Office's argument is further insufficient to overcome the teaching of Remington that contravenes combination with the application's background section.

In the Office's "Response to Arguments" section on page 6 of the Office Action, the Office states that the "motivation for combining" the references "is the knowledge generally available to one of ordinary skill in the art." But the Office provides no evidence of this alleged knowledge. If it is so generally known, the Office should be able to provide evidence. In any case, the Office must provide evidence showing this knowledge with specificity as required by the Federal Circuit in *In re Kotzab, supra.* The Office has not done so. For at least this reason, Applicant submits that the Office fails to establish a *prima facie* case of obviousness in rejecting Claim 23.

For any one of the many reasons set forth above, the Office fails to establish a *prima facie* case of obviousness in rejecting Claim 23. Applicant respectfully requests that the Office withdraw the rejection of Claim 23.

Claims 24-28 depend from Claim 23 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features that, in combination with those recited in Claim 23, are neither disclosed nor suggested in references of record, either singly or in combination with one another.

Conclusion

All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the present application. Should any issue remain that prevents immediate issuance of the application, the Examiner is encouraged to contact the undersigned attorney to discuss the unresolved issue.

Respectfully Submitted,

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